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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Atsushi SANO et al.

Group Art Unit: 4111

Application No.: 10/591,016

Examiner: S. ESSEX

Filed: August 29, 2006

Docket No.: 129239

For: FUEL CELL CATHODE MANUFACTURING METHOD AND FUEL CELL
MANUFACTURING METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the April 10, 2009 Restriction Requirement, Applicants provisionally elect Group I, claims 1-7, with traverse.

Applicants respectfully submit that the Office Action has failed to provide sufficient reasons that a single general inventive concept or corresponding special technical feature is absent from the instant claims. The Office Action asserts that the claims in Groups I, and II have different reactants and solvents and therefore have different special technical features. Applicants disagree on the grounds that the search and examination of at least the claims of Group I would result at least finding the reactants and solvents as indicated in the claims of Group II. Thus, the claims of Groups I, and II have at least a single general inventive concept or corresponding special technical feature so as not to create an undue search burden.

Further, Applicants respectfully submit that there exists *a priori* unity of invention with respect to claims 1-8, by virtue of the fact that claims 2-4, 7, and 8 variously depend

from claim 1. As stated in Chapter 10.06 of the ISPE (*International Search and Preliminary Examination Guidelines*):

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claims and claims and then states the additional features claimed (Rule 6.4).

Therefore, each dependent claim shares at least each element or technical feature of independent claim 1. ISPE 10.07 further provides:

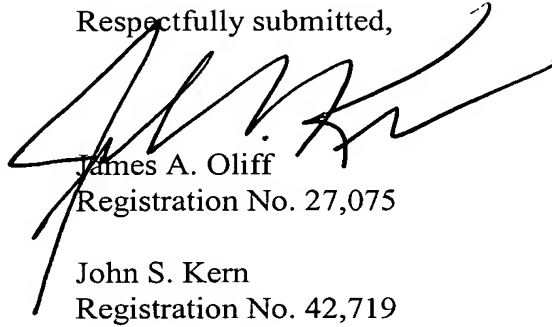
If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claims are known. See ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of independent claim 1 is known in the prior art. Therefore, Applicant respectfully submits that lack of unity of invention has not been established, and thus a Restriction Requirement at this time is improper.

Applicants respectfully requests withdraw of the Restriction Requirement and for the search and examination of claims 1-8.

Respectfully submitted,



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